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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/052,673	03/31/98	ANDERSON	11232

TM31/1107

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EXAMINER

RUPERT, P

ART UNIT	PAPER NUMBER
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2634

DATE MAILED: 11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/052,673

Applicant(s)

ANDERSON, RICHARD E.

Examiner

Paul N. Rupert

Art Unit

2634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7-10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 05 September 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Acknowledgement

1. This Office Action is in response to the latest Amendment and Proposed Drawing Corrections entered on 5 September 2000.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 5 September 2000 have been approved. Previous objections to the drawings are withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by David L. Mills, "RFC 1305 Network Time Protocol (Version 3)", March 1992. A method for determining the difference between local and remote clock frequencies and time values, and for adjusting the local clock frequency so that the difference approaches zero is fully disclosed by Mills (pp. 40-44 and Appendix G). The applicant's intended use of his invention within a digital data decoder does not render his invention patentable over the prior art because any general purpose computer can be programmed to be a digital data decoder, and NTP can be implemented on any general purpose computer. It would have been obvious to one of ordinary skill in the art

to utilize the gradual phase adjustment technique taught by Mills in order to synchronize two remote clocks over a network, regardless of the use to which the synchronized clocks are put.

Response to Amendment

5. Previous objection to the disclosure for numerous informalities is withdrawn.
6. Previous objection to the abstract for informalities is withdrawn.
7. Previous objection to claim 8 under 35 U.S.C. 112, second paragraph, is withdrawn.
8. Previous rejection of claims 1, 2, 6, 11 and 12 under 35 U.S.C. 102(a) as being clearly anticipated by Dokic (US 5699392) is traversed by argument and withdrawn.

Allowable Subject Matter

9. Claims 3-5, 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: the hardware which parses the time reference messages and only interrupts the processor when the difference between the local clock and the reference clock is greater than a threshold condition and then adjusting a clock frequency is not found in the prior art. In NTP, frequency changes to a clock are not made when a step change is necessary to a clock counter value.

Response to Arguments

11. Applicant's arguments filed 5 September 2000 have been fully considered but they are not persuasive.
12. Rejection of claims 1, 2, 6, 11 and 12 under 35 U.S.C. 102(b) as being clearly anticipated by David L. Mills, "RFC 1305 Network Time Protocol (Version 3)", March 1992, is maintained.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the problems presented by MPEG-2 clock recovery) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Applicant seems to be unaware that the techniques disclosed by RFC 1305 are quite capable of maintaining two or more clocks in synchronization over a network within a tolerance of nanoseconds, far exceeding the specifications of MPEG-2 (see RFC 1305 pp. 40 sec. 5 Local Clocks, lines 6-9). RFC 1305 contains specifications for standard-compliant hardware clocks in addition to software implementations (see appendix G and Figs. 10(a) and 10(b)).

In response to applicant's argument that the clock recovery algorithm is to be implemented in a digital data decoder for MPEG-2 clock recovery, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2634

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul N. Rupert whose telephone number is (703) 305-0194. The examiner can normally be reached on M-F 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Chin, can be reached on (703) 305-4714.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 308-9051 (for formal communications intended for entry)

Or:

Art Unit: 2634

(703) 308-6743 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington VA, Sixth Floor (Receptionist).

PNR

November 3, 2000



STEPHEN CHIN
SUPERVISORY PATENT EXAMINER
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